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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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05/15/2001

Jay S. Walker

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06/30/2006

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EXAMINER

VAN BRAMER, JOHN W

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/855,300	<b>Applicant(s)</b> WALKER ET AL.	
	<b>Examiner</b> John Van Bramer	<b>Art Unit</b> 3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed on April 10, 2006, cancelled no claims. Claims 1, 17, 22, 31, and 38 – 41 have been amended and no claims were added. Thus, Claims 1 – 43 are pending.

### ***Claim Rejections - 35 USC § 101***

2. The amendment filed on April 10, 2006 failed to correct the 35 U.S.C. 101 deficiencies in Claims 1 – 37, detailed in the Office Action dated December 6, 2005. Therefore, the 35 U.S.C. 101 rejection in the Office Action dated December 6, 2005 is maintained.

### ***Claim Rejections - 35 USC § 112***

3. The amendment filed on April 10, 2006 failed to correct the 35 U.S.C. 112 deficiencies in Claim 38 and Claim 39. While the amendment added additional steps the claims, the claims do not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to determine the step or steps needed to arrive at the invention commensurate in scope with the claims. Therefore, the 35 U.S.C. 112 rejection detailed in the Office Action dated December 6, 2005 is maintained.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 10-13, 20, 21, 23, 30, 31, 35-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Carson et al ("College Accounting, Eighth Edition).

Claims 1, 20, and 23: Carson discloses a billing statement comprising a description of a transaction and an offer pointer associated with the transaction, wherein the offer pointer comprising information for use to review an offer (page 331).

Claims 2 and 21: Carson discloses a billing statement as in Claims 1 and 20 and further discloses the billing statement is a printed document (page 331).

Claim 10: Carson discloses a billing statement as in Claim 1 above, and further discloses that the offer pointer is not an offer (page 331).

Claims 11, 12, 30, and 31: Carson discloses a billing statement as in Claims 1 and 20 above, and further discloses the billing statement describing a plurality of

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transactions and that the offer pointer is associated with one or more of the transactions (page 331).

Claim 13: Carson discloses a billing statement as in Claim 1 above, and further discloses that the offer is an offer to reduce the amount owed with the associated transaction (page 331).

Claims 35-37: Carson discloses a billing statement as in Claim 20 above, and further discloses that the amount owed is equal to the minimum payment (i.e. pay-in-full), equal to the cost of the transaction (i.e. pay-in-full), or equal to the total amount owed described in the billing statement (i.e. payment for all transactions)(page 331).

Claims 38 and 39: Carson discloses a method comprising generating a billing statement with a description of a transaction; and determining an offer pointer that can be used for review of an offer associated with the offer pointer (page 331).

Claims 40 and 41: Carson discloses a method comprising receiving transaction information, determining an offer/offer pointer based on the transaction information, and transmitting the offer pointer on a billing statement (page 331).

Claims 42 and 43: Carson discloses a method comprising receiving an offer pointer associated with a transaction on a billing statement, transmitting the offer to the

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customer, and determining a new amount owed by the customer if the offer is accepted (page 331).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3-9, 14-19, 22, 24-29, and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carson et al ("College Accounting, Eighth Edition).

Claims 3 and 22: Carson discloses a billing statement as in Claims 1 and 20 above, and further discloses the billing statement is a printed document. While it is not explicitly disclosed that the billing statement could also comprise viewable electronic data (i.e. electronic document), Official Notice is taken that it is old and well known to present billing and other financial information as viewable electronic data (i.e. computer displays). For example, for the past several decades customers have been able to access their financial data, to include statements, on electronic devices such as ATM machines. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the billing statement from viewable electronic data (i.e. an electronic billing statement). One

would have been motivated to provide an electronic billing statement in order to allow remote access to the data without necessitating printing, collating, and mailing a hard copy of the information to the customer.

Claims 4-9 and 24-29: Carson discloses a billing statement as in Claims 1 and 23 above, but does not explicitly disclose that the offer pointer is a URL, a telephone number, or a code associated with either of these. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the offer pointer (which directs the customer to the offer) would comprise of appropriate instructions based on the method by which the customer is to receive the offer. For example, Carson discloses an offer pointer ("See note below") on line 8 of the billing statement which directs the customer to the offer (in the "AGENT PLEASE NOTE" section) printed on the bottom of the billing statement. If the offer consisted of a number of terms which would not have fit on the bottom of the page, the pointer would have directed the customer to the appropriate location, such as "See page 2", "Call (202) 111-1111 for terms of offer", "Terms of offer available at 2021 Roosevelt Street, Alexandria, VA 20221", "Terms of offer available at www.offer.com", "Terms of offer may be requested via fax at (202) 111-1112", etc., depending on the communicative abilities of the billing statement provider's system. One would have been motivated to update the 1960's billing statement of Carson to include more modern communication means, such as a telephone number or URL,

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in order to take advantage of the latest communication means available at the time of invention.

Claims 14-16: Carson discloses a billing statement as in Claim 1 above, and further discloses the terms of the offer is to reduce the amount owed for the transaction.

While it is not explicitly disclosed that the terms of the offer is to reduce the interest rate, to extend the due date, or to eliminate the minimum amount due, these are all well known types of offer terms used by billers to entice customers to remit payments early, to use a particular form of remittance (electronic vs check), etc.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to set the terms of the offer so as to eliminate the minimum amount due, extend the due date, or change the interest rate. One would have been motivated to set different terms for different offers in order to give the biller more latitude in selecting offers to present.

Claims 17 and 32: Carson discloses a billing statement as in Claims 1 and 20 above and further discloses the billing statement comprises a second description of a second transaction, but does not explicitly disclose a second offer pointer associated with the second transaction. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the same or different offer terms for each of the transactions listed on Carson's billing statement. One would have been motivated to provide separate offers for separate transactions



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in order to allow the biller to "push" certain types of transactions. For example, a biller may give a straight 2% discount for all transactions paid within 7 days and may give an additional 2% discount for each transaction over \$100 to entice the purchaser to make higher value transactions.

Claims 18 and 33: Carson discloses a billing statement as in Claims 17 and 32 above, and further discloses the second offer is the same as the first offer (i.e. the same offer pertains to all of the transactions listed on the billing statement)(page 331).

Claim 19 and 34: Carson discloses a billing statement as in Claims 1 and 20 above, but does not disclose that the offer is located adjacent to the transaction description. However, it is a design choice of the biller on where to place the various information and data on the billing statement page. It would have been obvious to one having ordinary skill in the art at the time the invention was made to place the offer adjacent to the transaction information to which the offer pertains. One would have been motivated to place it adjacent in order to allow the customer to quickly identify which offer pertained to which transaction (if the offers were not all the same).

### ***Response to Arguments***

8. Applicant's arguments filed April 10, 2006 have been fully considered but they are not persuasive.

- a. The applicant argues that the invention is directed to a new and novel article of manufacture. However, the examiner is unable to determine from the metes and bounds of the claim that the invention fits into any statutory class. The claim as currently written could be a verbal statement to a customer that they are purchasing a item and indicating how much they owe, and pointing to a price indicated on the register. Alternatively, as stated in the previous office action the claim may be directed to printed matter on a document. The applicants admits that it is intended to be an article of manufacture (Amendment, Page 11, lines 1 – 3), and states that no printed matter is being claimed (Amendment, Page 12, line 17), and that the difference between the invention and the prior art lie in limitations of the claims other than any printed matter (Amendment, Page 12, lines 17 – 19). Additionally, the applicant further admits that the claims are not method claims and that the claims are not necessarily computer-related (Amendment, Page 13, lines 4-5). Given the arguments and admissions from the applicant the examiner is unable to verify the applicants claim that the invention is an article of manufacture. The examiner can not fathom an article of manufacture containing a description of a transaction that is not printed matter and not related to a computer that contains an offer pointer. Even the example of a verbal statement requires a computer display and/or printed matter.
- b. Applicant argues that there is no offer pointer illustrated anywhere on the Carson statement. However, Carson contains many offer pointers such as “(see note below)”, “(-)”, and arrows to various values. Additionally the applicant argues that

Carson does not disclose "determining an offer pointer". The applicant has not disclosed how the step of determining is accomplished. However, the Carson reference does disclose varying amounts upon which various calculations have been performed based upon offer pointers such as "(-)". Since this points to a value that is subtracted from the previous value, the examiner believes this offer pointer is determining the step to take regarding the number in which it points, since this information is for use to review the following value.

- c. The applicant argues that Carson does not disclose an offer to reduce the amount owed associated with a transaction, and then transmitting an offer to the customer that is associated with the offer pointer. However, the "(see note)" offer pointer is an offer transmitted to the customer from the page in which the customer is offered a reduction in the amount owed.
- d. The applicant argues that Carson fails to teach the processes in claims 42 and 43. Specifically, receiving from a customer an offer pointer associated with a transaction and transmitting an offer to the customer. However it is inherent, based upon the AGENT PLEASE NOTE: section that a copy of the statement, which contains offer pointers, is transmitted to the serving agent. Additionally, it is inherent that the next billing statement sent will determine a new amount owed by the customer that is associated with the various pointers, this is identified under the Balance column in Carson. Regarding claim 43, when a customer looks at the billing statement they are requesting to review the offer pointers, including the offer pointer to reduce the amount owed. The image they see is the

offer that has been transmitted to the customer's eyes. When the customer looks at the "Net Amount (After Deducting 2% special compensation, if earned)" the page is determining the new amount owed by the customer if the offer is accepted.

- e. The applicant argues that there is no support in Carson that a billing statement could include viewable electronic data. However, since no structure supporting and electronic device has been claimed, the examiner has interpreted this language to mean "data, that is viewable, and has been created on an electronic device". It is obvious that the Carson statement has been typed and not hand written. The only issue preventing the Carson statement from being inherent is that it would be possible to type the statement on a manual typewriter. However, it would have been obvious to one of ordinary skill in that art at the time the statement was created to use an electronic typewriter or computer. One would have been motivated to do this in order to use technology that is more common at the time rather than try to find an old manual typewriter that is still functioning.
- f. The applicant argues that there is no disclosure in Carson to support that the offer pointer would comprise appropriate instructions. However, Carson demonstrates this when he created the offer pointer "(SEE NOTE BELOW)".
- g. The applicant argues that Carson does not teach or suggest providing the same or different terms for each transaction listed. However, the Carson reference demonstrates using different terms for each transaction listed.

- h. The applicant argues that Carson does not disclose that the second offer is the same as the first offer. However, noting that a previous balance is listed as being carried forward from the previous statement, and also noting that the "Agent Please Note" section is a standardized discount contained on the statements. The examiner asserts that one of ordinary skill in the art at the time the invention was made would understand that the offer on the Carson statement represents the second offer, which is the same as the offer on the previous statement.
- i. The applicant argues that Carson does not teach or suggest placement of an offer pointer adjacent to a description of a transaction. However, Carson teaches by demonstration that the offer pointers (identified in paragraph 8b of this office action) are placed adjacent to the description of a transaction.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory

period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 9am - 5pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
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